

Applicant : William Shapiro, et al.
Serial No. : 10/699,124
Filed : October 31, 2003
Page : 2 of 9

Attorney's Docket No.: 07844-0621001 / P572

REMARKS

Claims 1-19, 21-41, and 43-57 are pending, with claims 1, 12, 19, 23, 34, 41, 45, and 56 being independent. Reconsideration and allowance of the above-referenced application are respectfully requested.

Information Disclosure Statements:

This response is filed along with an information disclosure statement (IDS). Consideration of the art listed therein is respectfully requested. In addition, please note that an IDS was filed in this case on October 31, 2003 (with the original application), and another IDS was filed in this case on September 21, 2007. The signed 1449 forms for these two IDS's have not yet been received. Please provide copies of the signed 1449 forms for these two additional IDS's to show that the art cited therein has been considered.

Rejection under 35 U.S.C. § 101:

Claims 1-19, 21 and 22 are rejected under 35 U.S.C. § 101 as allegedly not falling within one of the four statutory categories of invention. The rejection is respectfully addressed.

Independent claim 1 recites, “synchronizing offline access information with the client[.]” Independent claim 12 recites, “synchronizing offline access information with a document control server[.]” Independent claim 19 recites, “encrypting an electronic document; and incorporating into the encrypted electronic document an address of a document control server[.]” These recitations clearly constitute transformations of underlying subject matter. Moreover, the plain

meaning of the claim language demonstrates that the claims do not attempt to preempt all uses of a general idea because they are directed to particular types of data. Finally, the Office's contention that the claimed subject matter can be "completely performed mentally, verbally or without a machine" should be reconsidered, since the plain meaning of the full claim language necessarily excludes such possibilities.

For all the above reasons, withdrawal of the rejection of claims 1-19, 21 and 22 under 35 U.S.C. § 101 is respectfully requested. Absent this, a telephone interview is requested to discuss any changes in wording necessary to clarify the nature of the claimed subject matter.

Rejections under 35 U.S.C. §§ 102 & 103:

Claims 1, 4-19, 21-23, 26-41 and 43-57 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7,380,120 to Garcia. Claims 2-3 and 24-25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garcia in view of Official Notices. These rejections are respectfully addressed.

Claim 1 recites, "receiving a request from a client to take an action with respect to a first electronic document, the action unrelated to a second electronic document; and synchronizing offline access information with the client, in response to the request, to pre-authorize the client, to allow actions by a user as a member of a group of users, by sending to the client an update to offline access information retained at the client, the update comprising a first key associated with the group, the first key being useable at the client to access the second electronic document while

offline by decrypting a second key in the second electronic document.”¹ Garcia fails to describe this subject matter, where offline access to an electronic document is provided in response to a request to take an action that is unrelated to the electronic document for which offline access is provided.

The Office now cites to a new portion of Garcia in support of the rejection,² but this new portion merely describes Garcia’s offline access model, in general, and does not address the claimed subject matter:

In still yet another aspect of the present invention, a client module in a client machine activates an off-line access module to provide an off-line access mechanism for those users on the go. When a user decides to be away from a network premises or on a business trip, an off-line access request may be generated by an off-line access module in the client machine and forwarded to an AC server. In response, the AC server may grant the off-line access request to the user as well as the client machine from which the user will access secured documents off-line. According to one embodiment, the AC server may provide amended or tentative access rules, access privileges or a user key that will automatically expire when a predetermined time ends or become invalid the next time the client machine is connected to the AC server. As a result, the user can access some or all the secured documents in the client machine and, at the same time, create secured documents, all accessed or secured with the tentative access rules, access privileges or the user key. During the off-line access period, an access report manager may be activated to record all activities of the user accessing the secured documents. When the client machine is once again connected to the AC server, the access activities of the secured documents can be

¹ See Claim 1 (emphasis added).

² See e.g., 05-14-2009 Office Action at page 3.

reported to the AC server to facilitate the access control management and synchronization of the secured documents accessed or created off-line.³

Nothing here (or elsewhere) in Garcia suggests that offline access information is synchronized to provide offline access to a second document in response to receiving a request to take an action with respect to a first document, where the action is unrelated to the second document. To the contrary, the requests described here and elsewhere in Garcia are clearly related to the document for which offline access is provided.

According to Fig. 7B of Garcia and the corresponding description, a server provides off-line access to selected documents in response to a client request for offline access for those selected documents.⁴ For example, Garcia explains that “[w]hen a user has decided to be away from a company's premises for a certain period and will need to access some secured documents in a client machine ... [a] preauthorization request is made in the client machine to seek an approval of an off-line access request for a server.”⁵ After the server processes the off-line access request, “the user's access privilege or the access rules in the selected secured documents [are] updated for the requested period.”⁶ Thus, Garcia does not describe providing offline access to an electronic document in response to a request to take an action that is unrelated to that electronic document. The present application explains an example of the claimed invention as follows:

The request 1130 can be any type of request sent to the server 1120 periodically, such as a request from the client 1110 to take an action with respect to a document

³ See Garcia at col. 4, lines 25-50.

⁴ See Garcia at col. 32, line 47, to col. 34, line 15.

⁵ See Garcia at col. 32, lines 50-57.

⁶ See Garcia at col. 33, lines 17-19 (emphasis added).

1135, which may be located at the client 1110 or elsewhere and may be a secured document or not. The server 1120 can verify an authenticated user at the client 1110 in connection with the request 1130, and this verification of an authorized user can cause the synchronization operation to initiate. For example, the server 1120 can be a server such as any described above, and the synchronization operation can piggyback on other operations that use authentication (e.g., when a user attempts to access or secure a document while online).⁷

Nothing in Garcia teaches or suggests this subject matter as claimed.

Moreover, the Office has failed to provide a reasoned basis for how the claims can be considered to read on Garcia. The Office submits that “Garcia does in fact teach the amended portion, an action unrelated to a second electronic document (col. 4, lines 25-50, create documents off-line and synchronizing when back online).”⁸ However, the claimed subject matter does not specifically relate to the creation of documents while offline and synchronization after offline work. Rather, the claimed subject matter covers synchronizing offline access information before going offline, so previously created documents can still be accessed while offline. The Office has failed to address this subject matter, or how Garcia can be considered to teach this subject matter as a whole.

For at least the above reasons, the rejection of independent claim 1 should be withdrawn. Claims 2-11 depend from claim 1 and should thus be allowable over Garcia based on this dependence from claim 1 and the additional recitations they contain. Independent claims 12, 23, 34, 45 and 56 recite features similar to those of claim 1. Thus, for at least the reasons discussed above with regard to claim 1, the rejection of claims 12, 23, 34, 45 and 56 should be withdrawn.

⁷ See Present Application at ¶ 119 (emphasis added).

⁸ See 05-14-2009 Office Action at page 2.

Claims 13-18, 24-33, 35-40, 46-55 and 57 depend from claims 12, 23, 34, 45 or 56, and should thus be allowable over Garcia based on this dependence from an allowable base claim and the additional recitations they contain. Accordingly, withdrawal of the rejection of claims 1, 2-18, 23, 24-40, and 45-57 is respectfully requested.

Independent claim 19 recites, among other things, “incorporating into the encrypted electronic document an address of a document control server, document-permissions information, and an encryption key useable in decrypting the encrypted electronic document, the encryption key being encrypted with a key generated by, and associated with a group of users of, the document control server.” The Office has apparently admitted that Garcia fails to disclose these claimed features, stating, “adding an address (claim 19) to the myriad of items already taught by Garcia would have been obvious, and Examiner submits that it the address is inherent to the system, in order for the client to know to which server it needs to communicate, transparently.”⁹

First, it should be noted that the rejection of claim 19 is under 35 U.S.C. § 102(e). Since the Office is now relying on an assertion of obviousness for the rejection of claim 19, the rejection of claim 19 under 35 U.S.C. § 102(e) must be withdrawn as a matter of law. Second, the obviousness contention is improper and should also be withdrawn. The Office asserts that adding an address would have been obvious, without providing the reasoning in support thereof, as required by law.¹⁰ Note that the Office’s assertion of inherency is reason to have a server

⁹ See 05-14-2009 Office Action at page 2.

¹⁰ See *KSR Int'l Co. v. Teleflex*, 127 S.Ct. 1727, 1741 (2007) (“rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

address stored somewhere, not in the document in particular, and that the “myriad of items already taught by Garcia” actually teaches away from adding the additional information of the address since Garcia’s description of a “myriad of items” suggests that this list is comprehensive.

Finally, regarding the Office’s assertion of inherency, this contention is specifically traversed and is not conceded. The Office states that “the address is inherent to the system, in order for the client to know to which server it needs to communicate, transparently.”¹¹ However, this fails to address the issue of where specifically the address of the server is located, as recited in the claim. The Office has not asserted, and has no basis for asserting that incorporating an address of a document control server into an encrypted electronic document is somehow inherent to the disclosure of Garcia.

For at least the above reasons, the rejection of independent claim 19 should be withdrawn. Claims 21 and 22 depend from claim 19 and should thus be allowable over Garcia based on this dependence from claim 19 and the additional recitations they contain. Independent claim 41 recites features similar to those of claim 19. Thus, for at least the reasons discussed above with regard to claim 19, the rejection of claim 41 should be withdrawn. Claims 43 and 44 depend from claim 41 and should thus be allowable over Garcia based on this dependence from claim 41 and the additional recitations they contain. Accordingly, withdrawal of the rejection of claims 19, 21, 22, 41, 43 and 44 is respectfully requested.

support the legal conclusion of the obviousness.” (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (emphasis added); MPEP § 2141(III)).

¹¹ See 05-14-2009 Office Action at page 2.

Applicant : William Shapiro, et al.
Serial No. : 10/699,124
Filed : October 31, 2003
Page : 9 of 9

Attorney's Docket No.: 07844-0621001 / P572

Conclusion

The foregoing comments made with respect to the positions taken by the Office are not to be construed as acquiescence with other positions of the Office that have not been explicitly contested. Accordingly, the arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

All of the pending claims are now in condition for allowance, and a formal notice of allowance is respectfully requested. Absent this, a telephone interview is requested to discuss the independent claims and the cited art.

Please apply any necessary charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Aug. 14, 2009



William E. Hunter
Reg. No. 47,671

Fish & Richardson P.C.
PTO Customer No.: 21876
Telephone: (858) 678-5070
Facsimile: (858) 678-5099